

REMARKS

I. STATUS OF THE CLAIMS

Claims 1-20 are pending in this application. Claims 1 and 11 have been amended by the present amendment. No new matter has been added.

In the Office Action, Claims 1, 3 and 11 are rejected under 35 U.S.C. § 103(a) (hereinafter, "Section 103(a)") as being unpatentable over Aravamudan et al. (U.S. Pat. No. 6,301,609, hereinafter, "Aravamudan") in view of Ilsen et al., (U.S. Patent No. 6,757,898, hereinafter "Ilsen").

Claim 2 is rejected under Section 103(a) as being unpatentable over Aravamudan and Ilsen and further in view of Gerace (U.S. Pat. No. 5,848,396, hereinafter, "Gerace").

Claim 4 is rejected under Section 103(a) as being unpatentable over Aravamudan and Ilsen and further in view of Kraft (U.S. Pat. No. 6,309,305, hereinafter, "Kraft").

Claims 5 and 6 are rejected under Section 103(a) as being unpatentable over Aravamudan and Ilsen and further in view of and McDowell (U.S. Patent Publication No. 2001/0034224, hereinafter, "McDowell").

Claims 7, 9, 10, 13, 17 and 19 are rejected under Section 103(a) as being unpatentable over Aravamudan and Ilsen and further in view of Patil (U.S. Pat. No. 6,625,460, hereinafter, "Patil").

Claim 8 is rejected under Section 103(a) as being unpatentable over Aravamudan and Ilsen in further view of Smith et al. (U.S. Pat. No. 6,333,973, hereinafter, "Smith").

Claim 12 is rejected under Section 103(a) as being unpatentable over Aravamudan, Ilsen and Patil and further in view of Gerace.

Claim 14 is rejected under Section 103(a) as being unpatentable over Aravamudan, Ilsen and Patil and further in view of Kraft.

Claims 15 and 16 are rejected under Section 103(a) as being unpatentable over Aravamudan, Ilsen and Patil and further in view of McDowell.

Claims 18 and 20 were rejected under Section 103(a) as being unpatentable over Aravamudan, Ilsen and Patil and further in view of Smith.

Applicant respectfully traverses all rejections and requests reconsideration.

A. REJECTION UNDER SECTION 103(A), ARAVAMUDEN IN VIEW OF ILSSEN

Claims 1, 3 and 11 were rejected under Section 103(a) as being unpatentable over Aravamudan in view of Ilsen. Independent claim 1 has been amended by the present amendment to recite “and if the initial receiving was associated with a request to register from someone other than the prospective user, tentatively registering an account for said prospective user by storing the matched unique identifier and client specific access address with said IM server under the unique identifier...”. In addition, claim 1 further recites that “wherein said notification invites registration of the prospective user if the initial receiving was associated with a request to register from someone other than the prospective user.”

Independent claim 11 has been amended to recite the “account processing means... configured to tentatively register an account for said prospective user if the initial receiving was associated with a request to register from someone other than the prospective user...and wherein the notification invites registration of the prospective user if the initial receiving was associated with a request to register from someone other than the prospective user...”

Applicant respectfully traverses Examiner’s rejection as explained below.

As explained in M.P.E.P. Section 706.02(j):

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The three above-mentioned criteria must exist at the time the claimed invention was made, according to the text of Section 103(a) itself. The Examiner has not established a prima facie case of obviousness using Aravamudan and Ilsen for at least the reasons stated below.

Aravamudan, Ilsen, Claims 1 and 11

Applicant's amended claim 1 and claim 11 recite "the initial receiving was associated with a request to register from someone other than the prospective user", "tentatively registering an account for said prospective user" and "the notification invites registration of the prospective user". However, not ALL of the elements of amended claims 1 and 11 are taught in Aravamudan and neither are they taught in combination with Ilsen. Examiner has also agreed that Ilsen does not provide for "inviting registration". (Office action, page 2, point 4). As none of these required elements is disclosed in Ilsen, there is no showing of a prima facie case of obviousness for failure to teach ALL elements of the claim.

Thus, none of the references, Aravamudan or Ilsen, teach at least "tentatively registering an account for said prospective user" and that "the notification invites registration of the prospective user". The lack of any one of the required three elements for a rejection under Section 103(a) would make claims 1 and 11 allowable over the teachings of Aravamudan in light of Ilsen.

Therefore, Aravamudan in light of Ilsen fail to teach or suggest ALL claim limitations as required to establish a prima facie case of obviousness. Accordingly, Applicant respectfully requests withdrawal of the rejection of Claims 1 and 11 under Section 103(a).

Dependent Claim 3

Dependent claim 3 includes all limitations of its respective base claim 1. Accordingly, Applicant respectfully submits that claim 3 is allowable for at least the same reasons as base claim 1, and requests withdrawal of the rejection of claim 3 under Section 103(a).

B. Rejection Under Section 103(a), Aravamudan and Ilsen in view of Gerace

Claim 2 depends on and includes all limitations of respective base claim 1. The deficiencies of Aravamudan and Ilsen have been discussed above in connection with claim 1. Gerace does not supply the deficiencies of Aravamudan and Ilsen.

Accordingly, Applicant respectfully requests withdrawal of the rejection of Claim 2 under Section 103(a).

C. Rejection Under Section 103(a), Aravamudan and Ilsen in view of Kraft

Claim 4 depends on and includes all limitations of respective base claim 1. The deficiencies of Aravamudan and Ilsen have been discussed above in connection with claim 1. Kraft does not supply the deficiencies of Aravamudan and Ilsen.

Accordingly, Applicant respectfully requests withdrawal of the rejection of Claim 4 under Section 103(a).

D. Rejection Under Section 103(a), Aravamudan and Ilsen in view of McDowell

Claims 5 and 6 depend on and include all limitations of their respective base claim 1. The deficiencies of Aravamudan and Ilsen have been discussed above in connection with claim 1. However, McDowell simply does not supply the deficiencies of Aravamudan and Ilsen. Accordingly, Applicant respectfully submits that claims 5 and 6 are allowable for at least the same reasons as is claim 1.

Accordingly, Applicant respectfully requests withdrawal of the rejection of Claims 5 and 6 under Section 103(a).

E. Rejection Under Section 103(a), Aravamudan and Ilsen in view of Patil

Claims 7, 9, 10, 13, 17 and 19 depend on and include all limitations of their respective base claims 1, 7 and 17. Claims 7 and 17 each depend on respective base claim 1. The deficiencies of Aravamudan and Ilsen have been discussed above in connection with claim 1. However, Patil simply does not supply the deficiencies of Aravamudan and Ilsen. Accordingly, Applicant respectfully submits that claims 7, 9, 10, 13, 17 and 19 are allowable for at least the same reasons as is claim 1.

Accordingly, Applicant respectfully requests withdrawal of the rejection of Claims 7, 9, 10, 13, 17 and 19 under Section 103(a).

F. Rejection Under Section 103(a), Aravamudan and Ilsen in view of Smith

Claim 8 depends on and includes all limitations of respective base claim 1. The deficiencies of Aravamudan and Ilsen have been discussed above in connection with claim 1. Smith does not supply the deficiencies of Aravamudan and Ilsen.

Accordingly, Applicant respectfully requests withdrawal of the rejection of Claim 8 under Section 103(a).

G. Rejection Under Section 103(a), Aravamudan, Ilsen and Patil in view of Gerace

Claim 12 depends on and includes all limitations of respective base claim 7. Claim 7 depends on base claim 1. The deficiencies of Aravamudan, Ilsen and Patil have been discussed above in connection with claim 1. Gerace does not supply the deficiencies of Aravamudan, Ilsen and Patil.

Accordingly, Applicant respectfully requests withdrawal of the rejection of Claim 12 under Section 103(a).

H. Rejection Under Section 103(a), Aravamudan, Ilsen and Patil in view of Kraft

Claim 14 depends on and includes all limitations of respective base claim 7. Claim 7 depends on base claim 1. The deficiencies of Aravamudan, Ilsen and Patil have been discussed above in connection with claim 1. Kraft does not supply the deficiencies of Aravamudan, Ilsen and Patil.

Accordingly, Applicant respectfully requests withdrawal of the rejection of Claim 14 under Section 103(a).

I. Rejection Under Section 103(a), Aravamudan, Ilsen and Patil in view of McDowell

Claims 15 and 16 depend on and include all limitations of respective base claim 7. Claim 7 depends on base claim 1. The deficiencies of Aravamudan, Ilsen and Patil have been discussed above in connection with claim 1. McDowell does not supply the deficiencies of Aravamudan, Ilsen and Patil.

Accordingly, Applicant respectfully requests withdrawal of the rejection of Claims 15 and 16 under Section 103(a).

J. Rejection Under Section 103(a), Aravamudan, Ilsen and Patil in view of Smith

Claim 18 and 20 depend on and include all limitations of their respective base claim 7 and 17. Claims 7 and 17 each depend on respective base claim 1. The deficiencies of

Aravamudan, Ilsen and Patil have been discussed above in connection with claim 1. Smith does not supply the deficiencies of Aravamudan, Ilsen and Patil.

Accordingly, Applicant respectfully requests withdrawal of the rejection of Claims 18 and 20 under Section 103(a).

II. CONCLUSION

The above-discussed remarks are believed to place the present Application in condition for allowance. Should the Examiner have any questions regarding the above amendments, the Examiner is requested to telephone Applicant's representative at the number listed below.

Respectfully submitted,

Date: 01/23/2006



Otto O. Lee (Reg. No.: 37,871)
Juneke Jackson (Reg. No.: 48,870)
Marie G. Capuyan (Reg. No.: 52,695)
Intellectual Property Law Group LLP
Attorneys for Applicant

Atty Docket No.: YSAP.CHIKKA.PT2
Contact No.: 408-286-8933